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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,892	11/17/1999	John S. Hendricks	5268	5151
38598	7590	05/17/2005	EXAMINER	
ANDREWS KURTH L.L.P. 1701 PENNSYLVANIA AVENUE, N.W. SUITE 300 WASHINGTON, DC 20006			LANEAU, RONALD	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/441,892	HENDRICKS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ronald Laneau	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 February 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-33,42-73 and 89-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-33, 42-73, and 89-96 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

***Response to Amendment***

1. The amendment filed on 02/24/05 has been entered. Claims 34-41 and 75-88 are canceled and new claims 89-96 are added and claims 1-33, 42-73, and 89-96 are now pending.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

All references used were cited by Applicant.

4. Claims 1-4, 6-12, 13-22, 24-27, 29-33, 42-45, 48-62, 64-68, 70-74, 86-89, 91-93, 95 and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulton (US 4,985,697) in view of Morales (US 5,663,757).

As per claims 1-3, 6, 19, 25-27, 30-33, 42-45, 50, 59, 60, 66-68, and 70-74, Boulton discloses a method for providing electronic commerce using an electronic book, comprising: displaying an electronic book (fig. 1, 156); receiving a user's selection of the product or service (col. 4, lines 6-8); presenting associated with the electronic book an identification of a product or service (identifying indexing points uniquely identify the product or service (col. 9, lines 31-38). Boulton does not disclose a request to purchase but Morales discloses a request to purchase the selected product or service (col. 4, lines 15-26); and performing a transaction to execute the purchase request (see abstract).

It would have been obvious to one of ordinary skill in the art to utilize the request to purchase a product or service order as taught by Morales into the system of Boulton because it would provide realtime instantaneous purchases of product or service.

As per claim 4, 6, 7, 47, 48, 92 and 96 Morales discloses a method of electronic payment for the product or service using a credit card or bank transaction, an apparatus wherein the module includes establishing an electronic communication with a web site for executing the purchase request as claimed.

It would have been obvious to one of ordinary skill in the art to utilize an electronic payment as taught by Morales into the system of Boulton for the same reasons given in claim 1.

As per claims 8 and 49, Boulton teaches a method wherein the presenting step includes displaying an icon identifying the product or service and the receiving step includes receiving selection of the icon by the user as claimed (fig. 1, 156).

As per claims 10-12, and 51-53, Morales teach displaying an advertisement relating to the product (see abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the advertisement display as taught by Morales into the system of Boulton because it would allow a user to click and display more information about the item being advertised on the display screen.

As per claims 15-18 and 56-59, Boulton teach a recording module for recording statistical information concerning purchases of the product or service (col. 11, lines 47-54).

As per claims 20, 21, 61, 62, 93, and 95, see rejection of claim 1. Boulton discloses prices for the products or service but does not disclose the steps of determining whether to accept the offered price and which criteria it was based upon but it would have been obvious to one of ordinary skill in the art at the time the invention was made to look for bargain such as discount, rebates on some of the products' offered prices as this becomes a norm now in the internet age for customers to book for the best available price or deal for a particular product, the examiner takes the Official notice as such.

As per claims 24 and 65, Boulton discloses a display system but neither Boulton nor Morales discloses displaying an hypertext link identifying the product or service and the receiving step includes receiving selection of the hypertext link as claimed but it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a display including hypertext link because it would make it easier for a user to access the contents of the link by just clicking on said link.

As per claim 40, the examiner interprets the claimed sample section to be a small window like a pop-up ad in a section of the display screen. Boulton teaches displaying a

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product on the screen, which can be considered, to be a sample section capable of presenting a sample of the product as claimed.

As per claims 22 and 63, neither Boulton nor Morales discloses an encryption module for encrypting the transaction for purchase execution of the purchase request, an encryption module including a module for using a digital signature but the examiner takes the Official notice that an encryption and a digital signature in electronic commerce are well known in the art because it would insure the security of the information being electronically transmitted over a network. And confirm at the other end that the right person has signed the document to authorize the transaction.

5. Claims 46, 49, 90 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulton (US 4,985,697) in view of Morales (US 5,663,757) and further in view of Pocock et al (US 5,014,125).

As per claims 38, 46 and 79, neither Boulton nor Morales discloses a digital coupon for use in purchasing the product or service but Pocock discloses the use of coupon for customer's discounts on a product or service as claimed (col. 17, lines 17-28). Pocock's coupon is considered to be digital since customer has to download said coupon in order to print it.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a coupon as taught by Pocock into the combined device of Boulton and Morales because it would give more incentives to an on-line shopper to buy a particular product at discounted price.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-33, 42-73, and 89-96 have been considered but are moot in view of the new ground(s) of rejection.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Ronald Laneau*

Ronald Laneau  
Examiner  
Art Unit 3627

5/6/05